



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,801	07/18/2003	Amir Belson	26427-704,302	3484

21971 7590 03/27/2006

WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304-1050

EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,801

Applicant(s)

BELSON ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The disclosure is objected to because of the following informalities: the continuation data in the first paragraph needs to be updated.

Appropriate correction is required.

2. The abstract of the disclosure is objected to because it should include that which is new to the art to which the invention pertains. Since Applicant's claims are assumed to set forth what Applicant believes is the invention, such subject matter should also appear in the Abstract. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 2 and 18 are objected to because of the following informalities: in claim 2, line 4, a comma should separate "body" and "each"; in claim 17, line 1, it is believed that "herein" was intended to be --wherein--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 10, “the global positioning system” lacks antecedent basis. Furthermore, the phrase “employing a scheme similar to that used in the global positioning system” is vague and indefinite as what “scheme” is exactly being referenced (i.e., what is the “scheme” of the global positioning system) and what constitutes being “similar” to that scheme.

As to claim 17, “the electronic memory” lacks antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 2-4, 6-11 and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Taniguchi et al. (U.S. Pat. 6,511,417).

Taniguchi et al. disclose an instrument (endoscope 6) having an elongated body (7) having a proximal end (8), wherein the distal end is selectively steerable (Note that col.11, line 37 states that the elongated body is “flexible” which inherently gives it the capability of being selectively steerable by any kind of external force (e.g., pushing against internal wall of organ), yet col.11, lines 38 states that the endoscope includes a “bending knob” which implies internal structure (e.g., wires connecting the knob to the distal end) which also provide the capability of selective steering). The elongated body includes a lumen (e.g., any of the channels provided for

Art Unit: 3739

the image signals, illumination light or forceps, note col.11, lines 41-60) and a plurality of segments (e.g., distal, middle, proximal, or active bending portion and flexible portion). A plurality of transponders (14i) are located on the elongated body (col.12, lines 35-38), each of the transponders having a signature (col.12, lines 38-41). An external navigation unit (22k,25-28, Fig.3) is adapted for detecting the signature of each of the transponders (col.12, lines 37-34 and col.13, lines 35-45). As to claims 3 and 4, note monitor 25. As to claim 6, Figure 1C showing the endoscope inside the patient. As to claim 7, although this claim is in the permissive form “may” and thus does not narrow the scope of the claim, the external navigation unit of Taniguchi et al. does electronically mark the position of the instrument (note image on monitor 25 in Figure 2, for example). As to claims 8 and 9, the transponders comprise a magnetic sensor (col.12, lines 35-36). Although claim 10 is indefinite, the sensing system of Taniguchi et al. appears to employ a “similar scheme”. As to claims 11, 14, 16 and 19, the method steps of advancing, tracking and displaying have been inherently addressed above with respect to the use of the apparatus disclosed by Taniguchi et al. As to claim 13 and 15, note that insertion into the anus and around the gastrointestinal tract is contemplated, for example. As to claims 17 and 18, since a three-dimensional model is formed from the instrument (stored in memory in 28, Fig.3) (col.28, lines 26-32), the instrument automatically conforms to the three-dimensional model.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3739

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grundl et al. (U.S. Pat. 5,586,968).

Taniguchi et al. discloses an endoscope that can be inserted into the anal canal but fails to disclose a datum speculum. However, Grundl et al. teaches use of a tube (16, Fig. 1) for aiding in the introduction of an endoscope into the anal canal. Tube (16) would meet the broadest interpretation of a speculum. It would have been obvious to one of ordinary skill in the art to have provided a speculum in the system of Taniguchi et al. for the reasons taught by Grundl et al. (“to prevent the patient from closing the anal sphincter muscle”, col. 7, lines 23-26).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al.

Taniguchi et al. disclose a system that performs the method steps as claimed for use, *for example*, in the gastrointestinal tract of a patient and thus fails to mention the insertion of the endoscope through an incision. However, procedures involving the insertion of an endoscope through an incision, instead of a natural orifice, are inarguably well known, performed and considered standard to the skilled artisan. Since the system of Taniguchi et al. does not require limitation to use through a natural orifice and insertion of an endoscope through an incision affords the same problems (col. 1, lines 30-35), it would be obvious to one of ordinary skill to have used the system of Taniguchi et al. in a procedure wherein the endoscope is inserted through an incision for the mere reason of providing bent-state feedback for smoother insertion.

Conclusion

Art Unit: 3739

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chang (U.S. Pat. 5,779,624)

Fujikura et al. (U.S. Pat. 6,719,685)

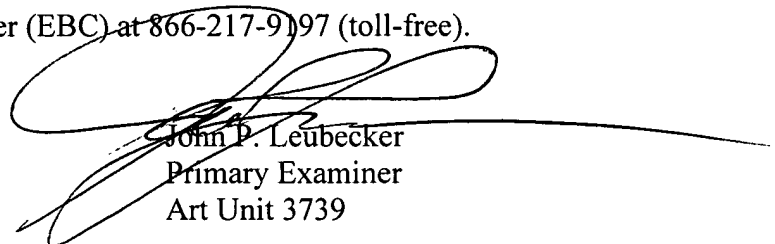
Ueda et al. (U.S. Pat. 5,681,260)

Garibaldi et al. (U.S. Pat. 6,902,528)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl